UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,626	01/11/2002	Olaf Gaertner		8106

7590 01/13/2004

Diller Ramik & Wight
7345 McWhorter Place
Merrion Square Suite 101
Annandale, VA 22003

EXAMINER	
STEPHENSON, DANIEL P	
ART UNIT	**PAPER NUMBER**
3672	

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,626	GAERTNER ET AL.	
	Examiner	Art Unit	
	Daniel P Stephenson	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27 and 29-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,13,18 and 20* is/are rejected.

7)☒ Claim(s) *12,14-17,19,21-27 and 29-33* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 2, 4-11, 13, 18, 20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray et al. '789 in view of the Japanese patent to Moriki et al. Murray et al. '789 discloses a construction machine that uses a milling drum. The roller consists of an internal, rotating roller (122) and a milling sleeve (140) with cutters on its outer surface. The sleeve is connected to the internal roller by fastening components (138) on its inner surface. The internal roller is driven by a drive device that is connected to a transmission unit (126) through the use of a drive rod (102). The milling sleeve is mounted in a rotationally fixed manner through the use of the fastening components at the end of the unit and is radially supporting units on the other end consisting of a support ring (152) and shoulders (151). The sleeve's fastening components project radially from the inside of the sleeve. The sleeve is arranged at a radial distance from the rotating roller and projects from it axially. The transmission unit is integrated into the rotating roller. The sleeve is supported in at least two axially spaced positions along the rotating roller. The supporting units (152) are radially integral to the sleeve. The support ring (152) is divided at the midway point when the sleeve is separated. The transmission unit is arranged at the end of the rotating roller opposite from the drive unit. Murray et al. '789 does not explicitly disclose that the sleeve is a one pieced sleeve. The Japanese patent to Moriki et al.

discloses a milling drum that is composed of one piece. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the one-piece drum of the Japanese patent to Moriki et al. on the apparatus of Murray et al. '789. This would be done so that there were fewer pieces and less chance of a malfunction.

3. Claims 3 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray et al. '789 in view of the Japanese patent to Moriki et al. Murray et al. '789 in view of the Japanese patent to Moriki et al. shows all the limitations of the claimed invention, except, neither Murray et al. '789 nor the Japanese patent to Moriki et al. disclose that the transmission element for the rotating roller is located at the drive side of the milling drum, nor do they disclose that the sleeve is attached only to the rotating roller. It would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the transmission element on the other side of the rotating roller and make the attachment of the sleeve only on the rotating rollers parts. This would be done since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Allowable Subject Matter

4. Claims 12, 14-17, 19, 21-27 and 29-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed 10/22/03 have been fully considered but they are not persuasive.

6. Applicant argues that Murray et al. does not suggest a one-piece milling tube that can be slidably mounted or removed from the roller base. Examiner concurs, however, Murray et al. has not been applied as an anticipatory reference but in combination with the Japanese to Moriki et al. that teaches a one piece milling tube that is inferred from the figures to slide over a roller base body 4a in the assembly of the milling drum. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine these to references, in this case, to reduce the number of parts in the machinery, which a common reasoning in the machining art. In the machining art it is notoriously conventional that reducing the number of parts within a machine reduces the chances that individual parts will fail.

7. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, the reason for combining is that it reduces the number of parts in the machinery which a common reasoning in the machining art.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P Stephenson whose telephone number is (703) 605-4969. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

David Bagnell
Supervisory Patent Examiner
Art Unit 3672

DPS